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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,948	10/28/2004	John Phillip Brown	04191	5306

23338 7590 05/29/2007  
DENNISON, SCHULTZ & MACDONALD  
1727 KING STREET  
SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER
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CHAMBERS, TROY

ART UNIT	PAPER NUMBER
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3641

MAIL DATE	DELIVERY MODE
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05/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/510,948

**Applicant(s)**

BROWN, JOHN PHILLIP

**Examiner**

Troy Chambers

**Art Unit**

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 8, 14 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 8, 14 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/29/2007.
2. Applicant's election with traverse of Group I, Species A in the reply filed on 01/29/2007 is acknowledged. The traversal is on the ground(s) that the restriction is not in compliance with the PCT "unity" requirements. This is not found persuasive because the examiner found a lack of unity in accordance with PCT rule 13.1 and is not aware of any rule preventing the application of a restriction requirement during the national stage.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

3. Claims 3-5 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 1 and 11 recite the limitation "said edge portion". There is insufficient antecedent basis for this limitation in the claim.

### **Claim Interpretation**

5. Applicant's claims are directed to the structure of a cap. Subject matter directed to any use of a barrel will not be given patentable weight since the barrel is introduced

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in the claims as being a function of intended use. In any event, the prior art references discussed below are clearly capable of attaching to the muzzle portion of a gun barrel.

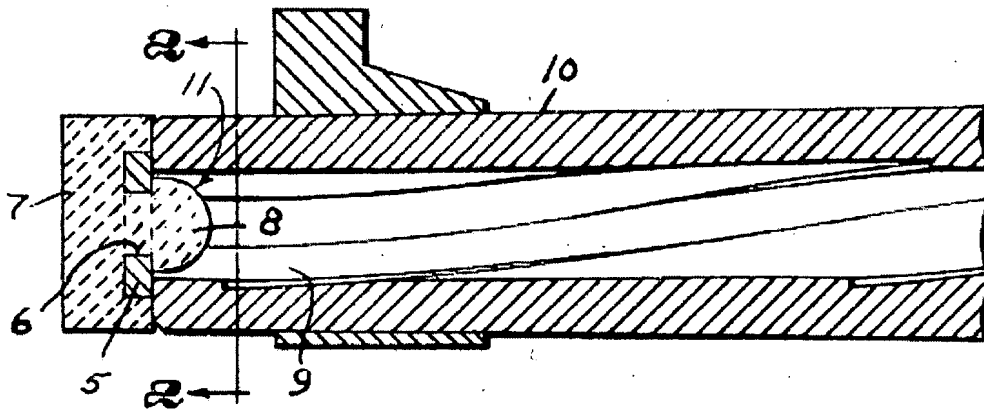
***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

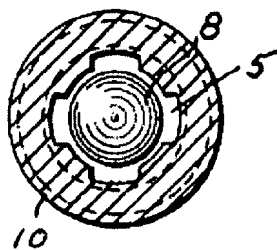
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

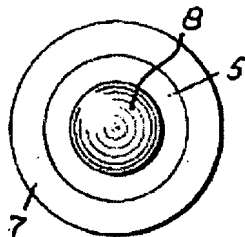
7. Claims 1, 6, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3593451 issued to McDonnell.



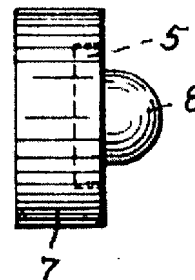
***Fig. 2.***



***Fig. 3.***



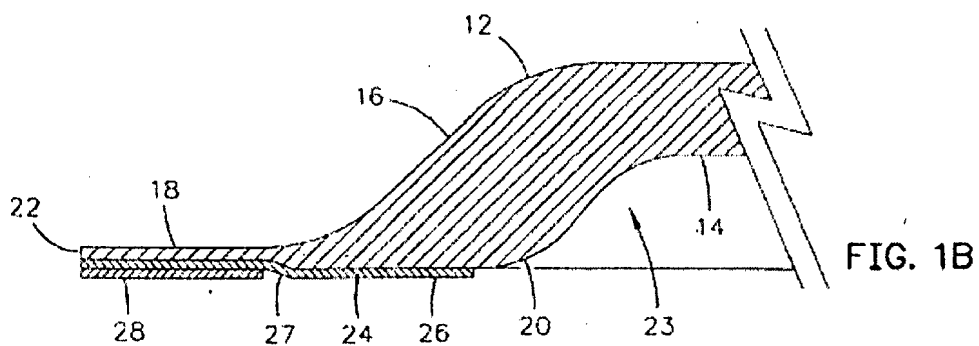
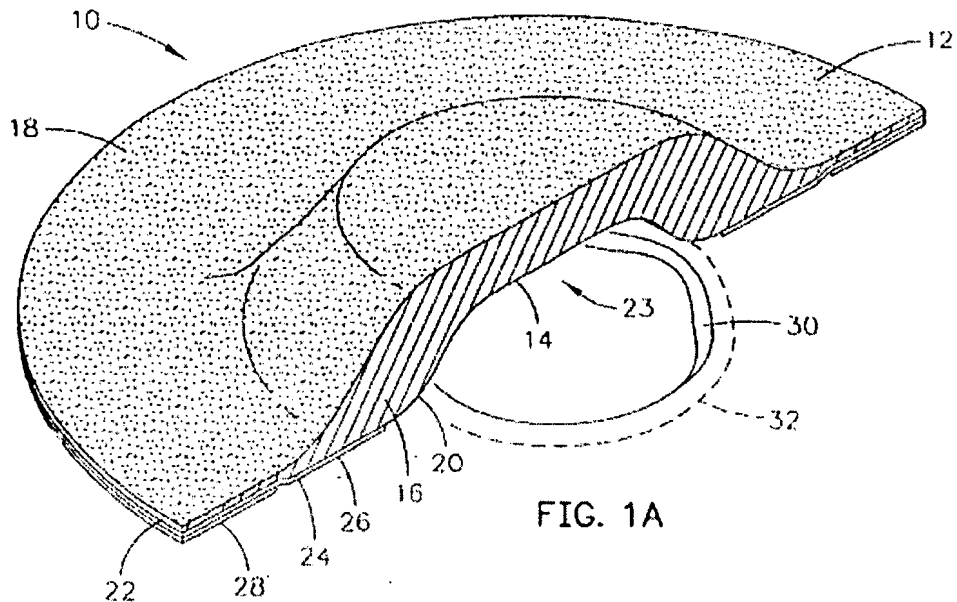
***Fig. 4.***



8. McDonnell discloses a cap for attachment to a barrel, comprising:

- a. a convex portion 8;
- b. a peripheral edge 7.

9. Claims 1-4, 6, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by 'JS 6320093 issued to Augustine.



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10. Augustine discloses a cap comprising:

- c. a central convex portion 14;
- d. a peripheral edge portion 18;
- e. a fluid impermeable barrier 26;
- f. a ring of adhesive material 28.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, 5, 9, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonnel in view of US 6122833 issued to Lorocco.

13. With respect to claims 2 and 3, McDonnel discloses a cap as discussed above with the exception of the adhesive portion 8. McDonnel discloses the use of a magnet

5. Lorocca discloses that a magnets and adhesives are equivalent structures (col. 4, ll. 10-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use adhesive rather than a magnet since the equivalence of magnets and adhesives for their use in the firearm art to attach elements to one another and the selection of any one of these known equivalents to attach would be within the level or ordinary skill in the art.

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14. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonnel and Lorocco and in further view of established case law. McDonnel and Lorocco disclose a combined cap as discussed above. However, the various different materials (aluminum, claim 5 and plastic, claim 9) are not disclosed by either reference. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the intermediate portion of aluminum and the convex portion of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

15. With respect to claims 10, 12 and 13, McDonnel and Lorocco disclose a combined barrel cap as discussed above. However, neither discloses the dimensions claimed by the applicant. However, such dimensions merely amount to a matter of engineering design choice and thus, while being a difference, does not serve in any way to patentably distinguish the claimed invention from the applied prior art. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). In this case, such dimensions are necessary so that the cap does not fall into the barrel of the gun.

16. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDonnel and Lorocco and in further view of US 6722073 issued to Cossio. McDonnel and Lorocco disclose a combined cap as discussed above with the exception of the camouflage or luminescent coloring. Cossio teaches that the use of bright or fluorescent coloring (col. 2, ll. 48-51). At the time the invention was made, it would have been obvious to apply the teachings of Cossio to the combined device of McDonnel and

Lorocco. The suggestion/motivation for doing so would have been to provide a readily visible cue to the user that the gun is being covered.

17. Claims 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine. Augustine discloses a barrel cap except for the claimed dimensions. However, such dimensions merely amount to a matter of engineering design choice and thus, while being a difference, does not serve in any way to patentably distinguish the claimed invention from the applied prior art. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited on form PTO-892 are cited as of interest to show similar types of caps. Moreover, the examiner is aware of a number of devices with the claimed configuration. For example, the examiner has worn contact lenses for a number of years. At least one year prior to the filing of applicant's application for patent the examiner has purchased contact lenses from a manufacturer wherein the lenses came in a package with a central convex portion to hold the lens and a square or circular perimeter about the convex portion. An aluminum cover was adhesively applied to the perimeter creating an airtight/fluid tight chamber for the contact. This is but one example of a number of similar type devices that should be considered by the applicant before submitting further arguments and/or amendments.

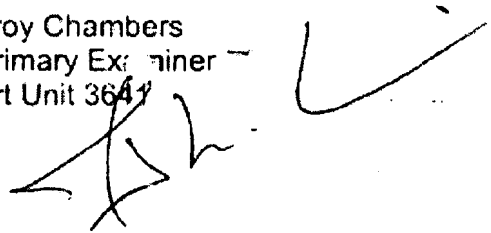
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Chambers whose telephone number is (571) 272-



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6874 between the hours of 7:00 a.m. to 3:30 p.m., M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone, can be reached at (571) 272-6873.

Troy Chambers  
Primary Examiner  
Art Unit 3641



TC  
04/14/2007